

Atty. Dkt.AAS104A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: Christopher S. Autterson

Serial No: 09/921,204

Filed: 08/02/2001

Group Art Unit: 3728

Examiner: John G. Pickett

Title: ADVERTISING METHOD AND PRODUCT

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REPLY BRIEF

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In response to the Examiner's Answer mailed February 23, 2006, appellant respectfully files this Reply Brief directed to the new points of argument raised in the Examiner's Answer.

As used herein:

"the last OA" refers to the Office Action mailed April 6, 2005;

"AB" refers to the Appeal Brief filed December 6, 2005;

"EA" refers to the Examiner's Answer mailed February 23, 2006.

It is respectfully submitted that EA page 4 presents appellant's arguments in an incomplete and/or distorted fashion.

1. The EA alleges that appellant argues that Ford does not disclose a shipping/packaging carton. However, in contrast, and to be complete and accurate, appellant respectfully submits that Ford does not disclose a shipping/packing carton, nor a shipping/packaging carton as alleged in the last OA. Underscoring added for emphasis; see AB page 13. Please also note what the last OA states: "Regarding claim 1, Ford provides a shipping/packing carton having the shape of a parallelepiped (Figure 1), and visibly printing directly on a first predetermined area of the outer carton surface of the shipping/packing carton a first visible advertisement of a first product contained within the carton (as shown, Figures 1-4)". Underscoring added for emphasis.

2. The EA alleges that appellant argues that Ford does not disclose an advertisement. However, in contrast, and to be complete and accurate, appellate respectfully submits that not only does Ford fail to disclose an advertisement, but Ford does not disclose a shipping/packaging carton having an advertisement printed on the outer carton surface. Underscoring added for emphasis; see AB pages 13-14.

3. The EA alleges that appellant argues that a person having ordinary skill in the art of methods of advertising would not look to Ford's box for holding a plurality of units, nor look to Zimmerman's carton, and a person having ordinary skill in the art of methods of advertising would not be skilled in profit, income, or package making.

However, in contrast, and to be complete and accurate, appellant argued:

at AB, paragraph bridging pages 14 and 15, "that one of ordinary skill in the art of methods of advertising, (to which claim 1 relates), would not look to Ford's box for holding a plurality of units of merchandise of a fixed size and character, nor to Zimmerman's container having a readily accessible invoice envelope to avoid the inconvenience and unpleasantness of

licking or otherwise pasting the adhesive flaps disclosed in the relatively complicated invoice envelope attaching means employed prior to Zimmerman (Zimmerman, col. 1, lines 16-27)";

at AB page 15, "that it would not have been obvious to one of ordinary skill in the art of methods of advertising for the first party to own the package so as to reduce the number of parties to which profits must be distributed, as alleged in the last OA";

at AB page 15, "that the last OA gives no support for the conclusion that it would be obvious for the first party to own the package so as to reduce the number of parties to which profit must be distributed. Is the last OA contending that one of ordinary skill in the art of methods of advertising is also one of ordinary skill in the art of reducing the number of parties to which profit must be distributed?";

At AB page 15, "The test under 35 USC 103 relates only to one of ordinary skill in the art of the subject matter sought to be patented, and not to one of ordinary skill in multiple arts or all arts";

at AB page 16, "that it would not have been obvious to one of ordinary skill in the art of methods of advertising (to which the subject matter of claim 1 is directed) to provide a carton (by combining the teachings of Ford and Zimmerman) with a second advertisement (bearing in mind that a carton of Ford-Zimmerman does not include a first advertisement as indicated above) taught by Jenniches in order to provide an additional source of income for the first party";

at AB paragraph bridging pages 16 and 17, "that the last OA takes the position that one of ordinary skill in the art of methods of advertising would also be skilled in the art 'to form the carton of Ford from corrugated cardboard in order to improve container wall strength,' and also in the art 'to reduce the number of parties to which profit must be distributed,' and also in the art 'to provide an additional source of income for the first party,' and also in the art 'to reduce the

steps in manufacturing'. Appellant respectfully submits that this is contrary to 35 USC 103 which deals with what would be obvious to a person skilled in the art to which the claimed subject matter pertains, and not skilled in various other arts";

at AB page 17, that "The law considers the artisan to have ordinary skill, and knowledge of all the prior art, in his or her field.... the law does not consider the artisan to be an expert in the art of making profit, nor to be an expert in who owns components of an invention, etc".;

4. The EA alleges that appellant argued that Jenniches does not teach a shipping/packaging carton. However, to be complete, appellant further argued at AB page 16 that "In contrast, Jenniches teaches a pack of cigarettes".

5. The EA states that appellant argued that none of the cited references are directed to a shipping carton. However, in contrast, and for completeness and accuracy, appellant argued at AB page 17, that "none of the cited references are directed to a shipping carton that advertises the products of the owner or sender of the carton, as well as the products of another party". Underscoring added for emphasis.

6. The EA states that appellant argued that the rejection is based on an excessive number of references. However, in contrast, and to be complete and accurate, appellant argued at AB page 18, that "the fact that the last OA resorts to three prior art references in an effort to allege the unpatentability of claim 1, is an indication in and of itself that the claim 1 invention is not obvious".

7. Nowhere in the last OA is it stated that "Ford describes the carton as 'boxed merchandise' that are shipped from the factory (Page 1, lines 17-20) and uses box and carton interchangeably (see for example Page 1, line 1). Accordingly, Ford constitutes a

shipping/packaging carton....", as now alleged on page 5 of the EA. Underscoring added for emphasis.

In contrast, the only mention of "shipped" appears at Ford, col. 1, lines 17-20, wherein it is stated "Considering piston rings as the boxed merchandise, it may be said that all boxes are shipped from the factory with the number of rings and the size thereof shown on one face of the box....". It is respectfully submitted that patent specifications must be interpreted with common sense. The quoted portion of Ford is similar to saying that the boxes of corn flakes are shipped from the factory, or that the packs of cigarettes are shipped from the factory. Common sense indicates that these boxes are shipped within a larger container or carton. It is respectfully submitted that common sense also dictates that one would not ship the piston rings in the same box without an outer or larger container because the box immediately containing the piston rings has openings or partial openings in the box side which would make it vulnerable to breakage in the course of transportation or shipping if it did not have an outer container or carton. See Ford, col. 2, lines 7-8, 22-23, 58-64.; col 3, lines 43-45, 54-61; col. 4, lines 20-21, 37-40, 57-58.

8. In response to the EA's contention that Jenniches constitutes a packaging carton (EA page 5), appellant respectfully traverses this, and specifically argues that Jenniches merely teaches a pack of cigarettes. Appellant respectfully requests that the Board take judicial notice that individual packs of cigarettes are contained in a carton of cigarettes, and Jenniches only teaches a pack of cigarettes.

9. The EA alleges that Ford teaches that the cartons are stacked on shelving with the indicia exposed (Page 1, lines 17-25) and thus the indicia may be considered a notice designed to attract public attention and constitute an advertisement within the definition presented by the appellant.

In contrast, appellant respectfully submits that Ford does not disclose an advertisement. In contrast, Ford discloses a box for holding and enclosing a plurality of units of merchandise of a fixed size and character, wherein, in the case of piston rings, the box is marked "with the number of rings and the size thereof shown on one face of the box, as for example, $12\ 3\frac{1}{4} + .010\frac{1}{8}$ ", and such other matter as may be descriptive of the ring characteristics, as for instance the word 'Compression'". See Ford, col. 1, lines 19-23, AB page 15.

It is respectfully submitted that the last OA and the EA set forth the fallacious argument that " $12\ 3\frac{1}{4} + .010\frac{1}{8}$ " constitutes an advertisement. In contrast, appellant respectfully submits that such designation merely constitutes "indicia denoting the content of the box when packed" Ford, col. 4, lines 49-51.

It is respectfully submitted that such type of reasoning would lead to the erroneous conclusions: that the word "lard" on a can containing lard is an advertisement; or that the word "salt" on a salt shaker is an advertisement; or that the word "flush" on a toilet is an advertisement; or that the word "gas" on a gas pipe is an advertisement; etc.

It is respectfully submitted that the EA must recognize that the foregoing examples are not advertisements, when one looks at the statement on page 6 of the EA where it is stated that "it is respectfully asserted that advertising, by its very nature, is concerned with increased sales and profit....".

10. In response to the paragraph bridging pages 5 and 6 of the EA, appellant respectfully submits that Jenniches relates to the remote art of a cigarette pack, and Ford relates to a remote art which "pertains to boxes or cartons designed primarily to hold and enclose a plurality of units of merchandise of a fixed size and character, and from which one or more units may be removed,

from time to time, the carton being again closed and restored to the position on the shelf from which it was withdrawn" (Ford, col. 1, lines 1-7).

"The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." *Ryto Manufacturing Co. v Nu-Start, Inc.*, 21 USPQ 2d 1053, 1057 (Fed Cir 1991), with underscoring added for emphasis.

"The examiner must ascertain what would be obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand". *Environmental Designs Ltd. v. Union Oil Co.*, 218 USPQ 865 (Fed Cir 1983), cert denied, 464 US 410 43 (1984).

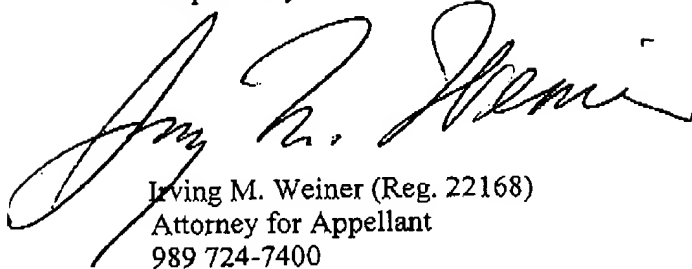
11. In response to the EA's comments on appellant's argument that the invention is in a crowded art, appellant respectfully submits that in a crowded art, it takes less of an advancement to obtain a valid patent. Otherwise, one would have to conclude that there can be no further patenting in that art.

Furthermore, appellant respectfully submits that no prima facie case of evidence has been made in light of the arguments and citations set forth in the AB and the present Reply Brief.

12. With regard to all of the other statements in the EA, appellant respectfully submits that the PTO bears the burden of establishing a case of prima facie obviousness, and in this case the PTO has not done so. In further support of this, attention is directed to *In re Dembiczak*, 50 USPQ 2d 1614 (the entire Section II thereof) (Fed Cir 1999).

Favorable consideration and reversal of the Final Rejection are earnestly requested.

Respectfully submitted,

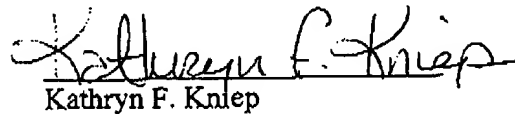


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I hereby certify that the foregoing Reply Brief and its enclosures were sent by facsimile to Commissioner for Patents at 571-273-8300 on April 20, 2006.


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